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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,843	12/21/2001	Christopher Robert Carlson	31890/1613	4914
27433	7590	11/18/2004		
FOLEY & LARDNER 321 NORTH CLARK STREET SUITE 2800 CHICAGO, IL 60610-4764			EXAMINER NGUYEN, PHONG H	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,843

Applicant(s)

CARLSON ET AL.

Examiner

Phong H Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-28 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-28 and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-9, 12, 14-21, 23-28, 30, 31 and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (3,768,177) in view of Taylor (5,511,472), Rasheed et al. (US Pub. 2002/0009695 A1) and Shimizu et al. (4,562,717).

Regarding claims 1, 2, 12, 17, 23, 31 and 36, Thomas teaches a base 10 with pegs 19 capable of being used as a base of an embossing system. See Fig. 1. Thomas does not teach an embossing apparatus. Taylor teaches an embossing apparatus having an upper template, a lower template and a scoring tool 19. See Figs. 1-5. Therefore, it would have been obvious to one having ordinary skill in the art to rest the templates as taught by Taylor on the base as taught by Thomas so that artists have a stable workplace to hold templates for embossing artworks. It is noted that the Taylor's templates would be rested on the top of backing board 20 in Thomas' base.

Thomas teaches artworks with textures in the background but does not teach texture plates. See Fig. 1. Rasheed et al. teach texture plates for creating textures on artworks. See Fig. 2. Therefore, it would have been obvious to one having ordinary skill in the art to incorporate texture plates as taught by Rasheed et al. to the embossing apparatus as taught by Taylor to create background textures for an artwork. It is noted

that as a user desires to create a background texture for an artwork, he/she would replace the Thomas' backing board 20 by a desired texture plate as taught by Thomas.

Taylor does not teach the size of the upper template and the lower template. Shimizu et al. teach the size of the upper template 2 is slightly larger than the size of the lower template 3 to create a pronounced embossment. See Fig. 10. It is noted that the drawing process and the embossing process are similar since both processes involve in raising a surface of a work piece into bosses. Therefore, it would have been obvious to one having ordinary skill in the art to make the size of the upper template to be slightly larger than the size of the lower template to create a pronounced embossment.

Regarding claims 3 and 27, a scoring tool 19 is best seen in Fig. 2 in Taylor.

Regarding claims 4, 5 and 26, the upper template, the lower template and the texture plate of Taylor are removably connected to the base of Thomas.

Regarding claims 6, 18, 19 and 25, the upper and the lower template are hingedly coupled to each other. See Fig. 4 in Taylor.

Regarding claims 7, 14 and 24, a depressed portion of the base 10 is best seen in Fig. 1 in Thomas.

Regarding claims 8, 9, 20, 21, 28 and 30, Taylor does not teach a specific thickness of the upper and the lower template but teaches the effecting of the thickness of the templates on a worked paper. See col. 1, lines 20-25. Therefore, it would have been obvious to one having ordinary skill in the art to use templates with appropriate thickness to accommodate a worked paper with different thickness or resiliency so that the worked paper would not be stretched beyond its breaking point during the embossing process.

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Regarding claim 15, a stylus 19 is best seen in Fig. 2 in Taylor.

Regarding claims 16 and 37, Taylor teaches two pegs on the lower template and two holes on the upper templates in order to align the templates together. See Fig. 5. However, as one uses those templates with a base having two pegs for aligning templates as taught by Thomas, it would have been obvious to one having ordinary skill in the art to replace two pegs on the lower templates as taught by Taylor by two holes so that both templates can mate with the pegs.

Regarding claims 33-35, Taylor teaches providing a light box to create an outline of the cutout on the paper to be embossed which acts as the guide for the embossing tool. See col. 1, lines 28-32. Therefore, it would have been obvious to one having ordinary skill in the art provide the base as taught by Thomas a light source as taught by Taylor in order to create an outline of the cutout on the paper.

3. Claims 10, 11, 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (3,768,177) in view of Taylor (5,511,472) and Rasheed et al. (US Pub. 2002/0009695 A1) as applied to claims above, and further in view of Carbone (6,216,354 B1).

The combination of Thomas, Taylor and Rasheed does not teach providing a grid pattern on the templates. Carbone teaches providing grid patterns 18 and 20 to help orient paper between the templates correctly. See Fig. 1 and col. 2, lines 31-35. Therefore, it would have been obvious to one having ordinary skill in the art to provide a grid pattern on the templates as taught by Carbone to help artists orienting paper on the templates correctly.

Response to Arguments

4. Applicant's arguments filed on 08/19/2004 have been fully considered but they are not persuasive.

Regarding the argument with respect to the newly amended claims 1, 12 and 23, the Examiner respectfully disagrees. Shimizu teaches a lower template 3 having an exposed outer edge around a perimeter of a shape when the lower template and an upper template 2 are in alignment wherein the upper and lower template interact to provide a crisp embossment.

Regarding arguments with respect to every single prior art, a single prior does not anticipate the claimed invention; a combination of prior arts does. Thus, the arguments are moot.

The Examiner suggests including the limitation of providing a scoring tool to trace a circumference of a shape to form a crisp embossment to the existent independent claims to overcome the prior arts.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 703-305-4989. The examiner can normally be reached on Mon-Fri.

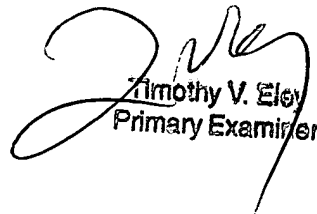
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN: *pn*

November 9, 2004


Timothy V. Eley
Primary Examiner